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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,671	10/09/2001	Hidetaka Magoshi	100809-16271 (SCEY 19.057	5777
26304	7590	07/07/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/973,671	MAGOSHI, HIDETAKA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This office action is in response to communication filed on 04/27/2006.
2. Claims 1-18 are presented for examination.
3. Amendments to claims 1, 2, 4, 5, 7, 8, 10-14, 16, and 17 have been entered and considered.

#### **Claim Rejections - 35 USC § 112**

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claims 2, 5, 8, 11, 12, and 14 are rejected under 35 U.S.C. 112.

Claims 2, 5, 8, 11, and 14 teach setting fees for the service beneficiaries at **discrete stages**. It is unclear what is the meaning of the term **discrete stages** in the claim. *Specifically, if the applicant is trying to claim a fee structure where one option is free or charge, another is a discount, etc, the applicant has to claim this clearly. A recitation of **discrete stages**, is unclear and renders the claim indefinite.* It is interpreted to mean that a variable fee structure is provided to the service beneficiaries.

5. Claims 12 teaches a client terminal unit with a **changing means** for assigning a change. It is unclear what is the meaning of the term **changing means** in the claim. It is interpreted to mean that there is a user interface or a webpage using which the client changes the type of service he desires. *While it*

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*appears the applicant indicates a desire to include a user interface in this claim according to the remarks, this is not however indicated in the amended claim.*

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-18 are rejected under 102(b) as being anticipated by *Toader Patent Number 5,774,869 (hereinafter Toader)*.

In reference to claims 1, 4, 7, and 16, *Toader* teaches a method, program, a computer-readable recording medium, and a program-executing apparatus of providing services that makes a computer execute the steps of: making service beneficiaries select at least one of the frequency and the quantity of advertising to be added the services provided (*i.e. giving the user the option to take an advertising survey and a guided tour of the sponsor's site to gain free Internet access*) (*abstract, col. 2 lines 41 to col. 3 lines 3, and Figures 1 and 3*), the services being provided when the selection is made (*i.e. user is prompted to make a selection for how the user would like to pay for the access or if the user would like to receive free access by completing another survey or providing additional information*) (*col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3*); and setting a fee for the provision of services to the service beneficiaries, according to at least one of the frequency and the

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quantity of advertising selected (*i.e. user can get free or regular priced access*) (*col. 2 lines 41-43, col. 2 lines 50 to col. 3 lines 3, col. 4 lines 57-to col. 5 lines 27*).

7. **Disclaimer:** Claims 2, 5, 8, 11, and 14 were found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 2, 5, 8, 11, and 14, *Toader* teaches the method, computer-readable medium of providing services, the program-executing apparatus (*i.e. a computer and a website*), the contents distribution system (*i.e. an Internet Entry Server*), and the computer-readable recording medium recorded with a contents distribution program (*i.e. software*) that makes a *computer* execute the steps of setting fees wherein the fees charged for the services to be provided to the service beneficiaries are set at *discrete* stages (*i.e. the amount charged is variable based on advertising content*) of the frequency and the quantity of advertising selected *by the selecting means of the client terminal unit* (*abstract, col. 2 lines 29 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 53, and Figures 1-4*) ; and at least one of the discrete stages includes *free of charge* (*i.e. free 30 minutes access and free refresh option*) (*abstract, col. 2 lines 41-45 and 60-67, col. 5 lines 10-27, and Figure 3*).

8. In reference to claims 3, 6, and 9, *Toader* teaches a method, computer-readable medium (*i.e. a website accessed via a computer*), and the program-executing apparatus (*i.e. a computer*) of providing services and the program-executing apparatus, wherein, at least one of the frequency and the quantity

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advertising selected can be changed during the provision the services (*i.e. the access fee when taking a survey or providing additional information is free and it's regular price without taking the survey or providing additional information*, and hence the user can change the quantity of advertising during the provision of the service by selecting among the options of paying for access or receiving it for free) (*abstract, col. 2 lines 60 to col. 3 lines 3, col. 5 lines 10-53, and Figures 2 and 3*).

9. In reference to claim 10, *Toader* teaches a contents distribution system (*i.e. an Internet Entry Server*), comprising: client terminal unit connected to a predetermined network (*i.e. to access the website, the user computer has to be connected to a network*) (*col. 2 lines 38-56 and Figure 1*), and having selecting means (*i.e. signing up, using the user interface, for the respective plan online with the option of free access with the surveys or paid access without the surveys*) for selecting at least one of the frequency and the quantity advertising be added to the contents be distributed (*col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3*); and distribution unit having distribution means distributing the contents added with the advertising corresponding to least of frequency and the quantity selected by the selecting means of the client terminal the client terminal via the predetermined network (*i.e. providing the survey or additional questions with the free access*) (*col. 2 lines 63-67, col. 5 lines 10-27, and Figure 3*), and charging means for charging a fee for the contents distributed to the client terminal unit (*i.e. user can pay with a credit card or by having the access billed to a 900 number*) (*col. 2 lines 63 to col.*

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*3 lines 3, col. 4 lines 57 to col. 5 lines 5, col. 5 lines 28-53, and Figures 2 and 4), according to at least one of the frequency and the quantity of advertising selected by the selecting means the client terminal unit (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3); wherein the selecting means communicates with the distribution means to perform the selection (i.e. user is asked and granted access when one of the refresh options is selected) (col. 2 lines 46-56, col. 5 lines 5-27 and Figures 2 and 3).*

10. **Disclaimer:** Claim 12 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 12 and 15, *Toader* teaches the contents distribution system wherein the client terminal unit has changing means for assigning a change and the computer-readable recording medium comprising and making a computer assign a change in at least one of the frequency and the quantity of advertising during the reception of the contents (i.e. user can select which access plan the user desires, *the one for full price or the one for free when the user answers survey questions*) (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3), *the changing means adapted to accept a modification of the selection of at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (i.e. multiple refresh options are presented)* (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3), and the distribution means of the distribution unit adds the advertising according to at least one of the frequency and the quantity

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changed by the changing means of the client terminal unit, and distributes the contents added with the advertising to the client terminal unit (*i.e. surveys, other questions, and a guided tour to a sponsor's website are added when free access is provided*) (*abstract, col. 2 lines 50-56 and 65-67, col. 5 lines 10-27, and Figure 3*).

11. In reference to claims 13 and 17, *Toader* teaches a computer-readable recording medium recorded with a contents distribution program and a contents distribution program, the contents distribution program comprising and making a computer execute the steps of: making a client terminal unit connected to predetermined network select at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (*i.e. the user making the decision for signing up, using the user interface, for the respective plan online with the option of free access with the surveys or paid access without the surveys*) (*col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 19, and Figures 2 and 3*); making a distribution unit connected to the predetermined network add the advertising corresponding to at least one of the frequency and the quantity selected by the client terminal unit to the contents, and distribute the contents added with the advertising to the client terminal unit (*i.e. providing the survey or additional questions with the free access*) (*col. 2 lines 63-67, col. 5 lines 10-27, and Figure 3*); and making the distribution unit charge a fee for the contents distributed to the client terminal unit, according to at least one of the frequency and the quantity of advertising selected by the client terminal unit (*i.e. user can pay with a credit card or by having the access billed to a 900 number*)



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*(col. 2 lines 63 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 5, col. 5 lines 28-53, and Figures 2 and 4); wherein the contents are distributed when the selection is made (i.e. user is granted access when the user selects one of the refresh options) (col. 2 lines 46-56, col. 5 lines 5-27 and Figures 2 and 3).*

12. *In reference to claim 18, Toader teaches the method of providing services wherein the selection is received via a user interface (i.e. user selects the refresh option on the computer interface) (abstract, col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 53, and Figures 1-4); and the services are provided via the user interface (i.e. user receives online access through the interface after making selections) (abstract, col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 53, and Figures 1-4).*

### **Response to Arguments**

13. After careful review of Applicant's remarks/arguments filed on 04/27/2006, the Applicant's arguments with respect to claims 1-18 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

14. The 112 Rejections are being maintained, since the Applicant's amendments to the claims fail to sufficiently addresses the issues previously raised by the Examiner in this case.

15. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

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**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) David DeKok's article titled "Low-priced Internet access offered  
Subscribers would see floating ad banners on PCs" in the Patriot –  
News on August 12, 1999 on page B.07. Teaches variable Internet  
access pricing structure based on the presence and absence of  
advertisements.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

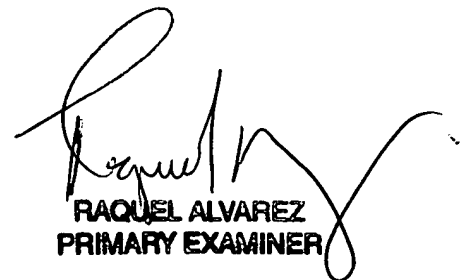
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N.B.

June 28<sup>th</sup>, 2006



RAQUEL ALVAREZ  
PRIMARY EXAMINER